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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/551,009

09/27/2005

Andrew Beger

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EXAMINER

LOEWE, ROBERT S

ART UNIT

PAPER NUMBER

1796

NOTIFICATION DATE

DELIVERY MODE

02/22/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents.admin@dowcorning.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/551,009	<b>Applicant(s)</b> BEGER ET AL.	
	<b>Examiner</b> ROBERT LOEWE	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Applicant's arguments/remarks, filed on 1/30/08, have been fully acknowledged.

#### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Freiberg et al. (US Pat. 6,132,664).

Claim 1: Freiberg et al. teaches a moisture-curable composition which cures to a rubber/elastomer comprising: (a) an organopolysiloxane having at least 1.2 silicon-bonded alkoxy/hydrolysable chain terminations per molecule (2:50-59). This satisfies the limitation that component (A) of instant claim 1 have not less than two hydrolyzable groups. Freiberg et al. further teaches (b) an alkoxysilane having the formula  $R_z^4Si(OR)_{4-z}$  where z can be 0, 1, or 2. When z is equal to 2, the organosilane has the formula  $G_2-Si-R^1_2$  of instant claim 1 (3:1-7). Freiberg et al. further teaches that the composition comprises (c) a filler (3:9), and (d) a photocatalyst (2:60-67). Freiberg et al. further teaches that when component (b) does not contain an unsaturated group, then component (e) is provided which can be a short chain siloxane (5:1-31).

Freiberg et al. does not explicitly teach that the cured rubber/elastomer body has a surface with a maximum gloss value of 45. However, Freiberg et al. teaches the same compositions as that of instant claim 1. The courts have stated that a chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties

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applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655, (Fed. Cir. 1990). See also *In re Best*, 562 F.2d 1252, 195 USPQ 430, (CCPA 1977). “Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established.” Further, if it is the applicant's position that this would not be the case: (1) evidence would need to be provided to support the applicant's position; and (2) it would be the Office's position that the application contains inadequate disclosure that there is no teaching as to how to obtain the claimed properties with only the claimed ingredients.

Claims 2 and 3: Freiberg et al. further teaches that the organosilane (b) can be vinylmethyldimethoxysilane (6:52).

Claims 4 and 5: Freiberg et al. further teaches that the filler (c) can be fumed silica and/or a fatty acid treated precipitated calcium carbonate (7:1-5).

Claims 6-8: Freiberg et al. further teaches that the photocatalyst is a titanate of the formula  $Ti(OR^5)_4$  where  $R^5$  is a hydrocarbon group. Examples include those found on column 8, lines 51-67. It is recognized by the examiner that component (d) is not referred to as a photocatalyst by Freiberg et al. However, because Freiberg et al. teaches the same species as those found in instant claims 6-8, it inherently follows that component (d) as taught by Freiberg et al. will function as a photocatalyst as claimed in instant claims 1 and 6-8.

Claim 9: Freiberg et al. further teaches that component (a) is a linear polydiorganosiloxane having terminal groups of  $-Si(R^2)_2-R^3-Si(R^2)_k(OR^4)_{3-k}$ . Examples include

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the polydiorganosiloxanes of formulas (I), (II), and (III) found on columns 4 and 5 and polymer 1 found on column 8 of Freiberg et al.

Claim 10: Freiberg et al. further teaches that component (e) can be an unsaturated organopolysiloxane having a degree of polymerization from 2 to 50 and at least two silicon bonded functional groups which are reactive with the alkoxy groups of component (a) (5:1-31). The value of “f” of structure (IV) is such that the viscosity of component (a) is within the range of 0.5 to 3000 Pa·s (3:38-41).

Claim 11: Using example 2A of Table 1, Freiberg et al. further teaches the composition of instant claim 1. Specifically, when normalizing the values of table 1 to account for 100 parts of component (a), Freiberg et al. teaches: 100 parts of component (a), 3.4 parts of component (b), 46 parts of component (c), and 2.3 parts of component (d) (Table 1, sample 2A). Sample 2A is just a representative example, as the other entries in table 1 also effectively teach instant claim 11.

Claim 12: Freiberg et al. further teaches an elastomeric product comprising the composition of instant claim 1 (1:8-19).

Claim 13: The Office realizes that Freiberg et al. does not explicitly teach all of the claimed physical properties. In the instant case, Freiberg et al. does not teach a cured sealant having an air-sealant interface surface with a maximum gloss value of 45. However, Freiberg et al. teaches all of the claimed ingredients in the claimed amounts. Therefore, the claimed physical property of instant claim 13 would inherently be achieved by the composition as taught by Freiberg et al. If it is the applicant's position that this would not be the case then evidence would need to be provided to support the applicant's position.

Claim 14: Freiberg et al. further teaches a method of using the composition of instant claim 1 as a sealant (2:5-10).

Claim 15: Freiberg et al. further teaches a method of forming an elastomeric mass between surfaces which is adherent to at least two such surfaces which method comprises introducing between the surfaces a mass of a moisture curable composition of instant claim 1 and curing the composition in the presence of moisture (7:25-8:30). While Freiberg et al. does not explicitly teach curing the compositions in the presence of light, such a limitation is considered inherent in Freiberg et al. especially when considering the experiment which measures cure rate measured by skin over time (SOT) (9:30-43). In said experiment, a stopwatch was utilized and the SOT was measured by lightly touching the surface with the end of a finger. This experiment requires the presence of light (both to see the stopwatch and to see the substrate so as to monitor the SOT), thus the presence of light during the curing step is inherent.

Claim 16: Since Freiberg et al. teaches that the amount of component (B) of instant claim 1 is present at, for example, 3.4 parts by weight based on 100 parts by weight of component (A). Since Freiberg et al. also teaches some of the same species of component (B), it inherently follows that Freiberg et al. teaches that component (B) contains from 0.2-7 parts by weight alkenyl content.

### ***Response to Arguments***

Applicant's arguments, filed 1/30/08, with respect to claims 1-15, have been fully considered but they are not persuasive. Specifically, applicants argue that Freiberg et al. does

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not provide any working examples which comprise a vinyl or unsaturated group containing component. However, the courts have stated that a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989).

Applicants further argue that Freiberg et al. does not teach curing in the presence of light. The rejection above sufficiently addresses this argument.

Applicants further argue that Freiberg et al. does not teach or suggest a composition for preparing an elastomeric product having a surface with a minimum gloss value of 45. The rejections cited above (claims 1 and 13) sufficiently address this argument.

Applicants further argue that Freiberg et al. discloses a large genus and as such does not anticipate the instant invention. On the contrary, Freiberg et al. teaches **only two** embodiments for component (A) (5:1-45). Component (A) in the composition may be a single polymer of formula (III) or it may be a mixture of polymers having formulae (III) and (IV), **both** embodiments being taught as preferred.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### *Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Loewe whose telephone number is (571) 270-3298. The examiner can normally be reached on Monday through Friday from 5:30 AM to 3:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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/R. L./  
Examiner, Art Unit 1796  
14-Feb-08

/Randy Gulakowski/  
Supervisory Patent Examiner, Art Unit 1796